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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,021	06/08/2000	TOSHIYA TAKEKUMA	1776/00050	9733

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EXAMINER

GORT, ELAINE L

ART UNIT PAPER NUMBER

3627

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/581,021

Applicant(s)

TAKEKUMA ET AL. *ST*

Examiner

Elaine Gort

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 47-70 is/are pending in the application.
- 4a) Of the above claim(s) 59-68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 47-58, 69 and 70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 59-68 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 7/23/04.

Applicant's election with traverse of claims 1, 47-58, 69 and 70 in the reply filed on 7/23/04 is acknowledged. The traversal is on the ground(s) that examination of one set of claims will require a search in the classes common to both sides of claims. This is not found persuasive because the inventions are distinct as process and apparatus for its practice and because the inventions have acquitted a separate status in the art because of their recognized divergent subject matter. See Restriction for further details.

The requirement is still deemed proper and is therefore made FINAL.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in June 29, 2000. A translation of the priority document is required.

Claim Rejections - 35 USC § 112

3. Claims 1; 47-58; 69 and 70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Although somewhat improved with the amendment, the claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

The claims continue to be replete with grammatical unclarity along with functional and indefinite language, failing to positively and distinctly set forth structure and its interconnection(s). *All of the claims should be reviewed for compliance and new claims submitted as necessary.*

Examples of terminology that should be reviewed for clarification follow:

In claim 1, line 4 it is unclear what is being output from the terminal devices. Does this mean that the bargain, the goods, or the information entered by the sellers and buyers is being output?

In claim 1, line 6 it is unclear what is meant by "executing a sale by pre-engagement". What limitations are being added by the term pre-engagement?

In claim 1, line 10 it is unclear what is meant by "sequentially concluding a plurality of sales for goods which remain unsold". How is the concluding of sales different from the first dealing executing a sale by pre-engagement? Or is it the same sale. It is unclear what is being claimed.

All of the claims should be reviewed for compliance and new claims submitted as necessary.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1; 47-58; 69 and 70 are rejected because they lack patentable utility.

Claims 1 and 47-70 only claim the manipulation of data but perform no concrete, useful or tangible result. The claims merely claim manipulation of data but do not perform any concrete, useful or tangible result. For example this objection may be overcome by claiming the output of a report, contractual agreement, or transfer of goods. The claims merely claim processing means for taking seller and buyer information to establish a bargain and do not positively claim the actual steps of taking of seller and buyer information and generating a sale, and thus only claim processing means. The sale and actions must be positively recited. Additionally the terminals are only functional language for the processing means and are not positively recited.

6. Claims 1; 47-58; 69 and 70 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Current office policy regarding method claims disclosed as requiring a computer but not claiming the use of a computer is to consider the claimed subject matter as non-statutory for failing to fall within the technological arts. Claims must be tied to a technological art. Tying the

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method to a computer would be one way to overcome this rejection. For example the claiming of a terminal could include a "computer terminal".

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1; 47-58; 69 and 70, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al. (US Patent 5,794,207).

Walker et al. '207 discloses the claimed goods dealing apparatus, system, method, and storage medium.

Walker et al. '207 discloses an apparatus/system/storage medium for buying and selling goods through a computer network comprising:

First and second deal processing means for executing and concluding a plurality of sales based on multiple buyer and multiple seller's information which includes date and location information relative to for example a flight date; and the collation of buyer and seller information when the buyer's and seller's information agree such as when a buyer's offer matches a seller's requirements.

Regarding where the market prices decline, this limitation is only included in the preamble and is thus given little patentable weight. Goods commonly decrease in value over time (depreciate).

Regarding cluster means of claim 51, the system utilizes databases to store various information from buyers and sellers.

Regarding shipping costs of claim 55, the cost of shipping is commonly provided to buyers for purchasing goods and thus is inherent to the system.

Regarding confirmation of availability of claim 58, the system confirms availability of flights/goods from sellers in order to complete the sale.

9. Claims 1; 47-58; 69 and 70, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (US Patent 6,112,185).

Walker et al. '185 discloses an apparatus/system/storage medium for buying and selling goods through a computer network comprising:

First and second deal processing means for executing and concluding a plurality of sales based on multiple buyer and multiple seller's information which includes date and location information relative to for example a flight date; and the collation of buyer and seller information when the buyer's and seller's information agree such as when a buyer's offer matches a seller's requirements.

Regarding where the market prices decline, this limitation is only included in the preamble and is thus given little patentable weight. Goods commonly decrease in value over time (depreciate).

Regarding cluster means of claim 51, the system utilizes databases to store various information from buyers and sellers.

Regarding shipping costs of claim 55, the cost of shipping is commonly provided to buyers for purchasing goods and thus is inherent to the system.

Regarding confirmation of availability of claim 58, the system confirms availability of flights/goods from sellers in order to complete the sale.

The prices may decline when the seller finds their forecasting errors have left availability for which they chose to offer discounts as the flight is nearing its departure at which time the seller's prices may drop as the ticket/upgrade will have little value to them after the airplane's departure.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1; 47-58; 69 and 70, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ordish (European Patent Application Publication 0434224A2) in view of Walker et al (US Patent 6,112,185).

Ordish discloses an apparatus/system/storage medium for goods dealing including processing means for processing buyer's and seller's information (special criteria entered by buyer and seller which includes conditions for purchase and sale,

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e.g. see column 6, line 42, book of bids and offers); and processing means for collating buying and selling information based on predetermined conditions and creating a sequential conclusion made with agreements (automatic matching transactions and conversation negotiate trading transactions) (creates, tracks and processes tickets, e.g. see figure 16 and 17); input terminal, browser, display (located at keystations); and host (networked, e.g. 2000).

Ordish discloses the claimed apparatus/system/storage medium for buying and selling goods thru a computer network but is silent regarding the goods losing or reducing their values after passage of a period of time and where either the buyer's or seller's information includes a date. Walker et al. '185 discloses that it is old and well known in the art of trading to trade airline tickets which lose or reduce their market values after passage of time and the trading of the tickets including date information (see column 2, lines 15+) to allow buyers and sellers to buy or sell when the value is declining and when the date is important. It is well known in the art of trade that goods may depreciate, perish and/or lose value based on many market conditions (e.g. passage of time in relation to the event of the airline flight). It would have been obvious to one having ordinary skill in the art at the time the invention was made that the dealing of Ordish could be carried out on trading goods that are losing value with time and when the date associated with the goods is important, in order to allow buyers and sellers to transfer goods that are losing value with time and when the date associated with the good is important.

Response to Arguments

12. Applicant's arguments filed 7/23/04 have been fully considered but they are not persuasive.

Applicant has argued that Walker et al. does not disclose where the buying information is correlated with selling information to obtain a sale where unsold goods are reoffered for sale under different conditions to result in sequential sales of remaining unsold goods. Examiner contends that Walker et al. does disclose the correlation (collating) of buyer and seller information when a match is made and a sale of unsold goods takes place. Unsold goods such as airline tickets are effectively reoffered until a buyer's information matches the required sale requirements and a sale takes place.

Applicant has argued that Walker is limited to a single buyer making a transaction with one seller. Examiner contends that Walker discloses transactions in which a plurality of purchasing requests from a plurality of buyers is used with a plurality of information for sellers to form a deal for unsold goods.

Applicant further argues that Walker does not continue making deals with unsold goods, until all the goods are sold, or a date passes in which the goods value has been lost. Examiner contends Walker does do this, for example the system will continue to offer a deal on a flight until the date of the flight at which the value of the ticket is zero once the flight takes off (empty seat).

In response to applicant's argument that Ordish and Walker are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the

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applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Examiner contends that both references deal with electronic commerce and thus are analogous art. The Examiner has used Walker's teaching of the depreciation of value of goods and the incorporation of a date in an offer to purchase goods and has provided an adequate motivation to explain how the references can be combined.

See rejections above for further details on Applicant's arguments.

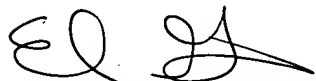
Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is (703)308-6391. The examiner can normally be reached on Monday through Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703)308-5183. The fax phone number for the organization where this application or processing is assigned is (703)872-9326.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

A handwritten signature in black ink, appearing to read 'EG' followed by a stylized flourish.

Elaine Gort, Examiner
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September 26, 2004